

### **REMARKS**

By this Reply, Applicants amend claims 1, 21, 25 and 26. Claims 1-26 remain pending in this application, with claims 1, 25 and 26 being independent. Support for the amendments can be found throughout Applicants' disclosure.

In the Office Action of September 27, 2007 ("Office Action"), claims 1-13, 15-17 and 19-26 were rejected under 35 U.S.C. § 102 based on U.S. Patent Application Publication No. 2002/0016818 ("*Kirani*"); and claims 14 and 18 were rejected under 35 U.S.C. § 103 based on *Kirani* in view of U.S. Patent Application Publication No. 2002/0184309 ("*Danker*"). These rejections are addressed below.

#### **Section 102 rejection of claims 1-13, 15-17 and 19-26**

The section 102 rejection of pending claims 1-13, 15-17 and 19-26 should be withdrawn because *Kirani* fails to disclose or suggest all of the features of Applicants' claims, as now amended. In order to properly anticipate Applicants' claims under § 102, a single prior art reference must disclose each and every element of the claim at issue, either expressly or under principles of inherency. Here, *Kirani* fails to disclose each and every element of the claims.

Amended independent claim 1 recites a combination including "delivering the electronic message to the destination with an un-altered, viewable version of the separated multimedia object and automatically saving the un-altered, viewable version of the separated multimedia object to a repository for subsequent use by a user." *Kirani* fails to disclose at least these features.

*Kirani* is directed to optimizing delivery of e-mail attachments. See Abstract. In particular, in *Kirani*'s system, an e-mail attachment is removed from the e-mail message and stored in a network repository. See Abstract; see also ¶ 0037. The body of the e-mail is reconstituted with alternatives for processing/consuming the object from the attachment. See ¶ 0037; see also ¶¶ 0071-0075. *Kirani* discloses that the e-mail recipient can receive a "transformation of the object in the attachment." *Kirani* at ¶ 0037. *Kirani* also describes that the recipient can receive a link that references a storage address of the original, full-resolution attachment. Additionally, *Kirani* describes a link for the "reformatted" attachment. *Id.* In any

case, *Kirani* makes clear that "the original attachments are removed from the messages and do not accompany the e-mail delivery." Abstract.

In contrast to *Kirani's* delivery scheme, independent claim 1 recites "delivering the electronic message to the destination with an un-altered, viewable version of the separated multimedia object and automatically saving the un-altered, viewable version of the separated multimedia object to a repository for subsequent use by a user." *Kirani* fails to disclose these features. Indeed, in *Kirani's* system, the delivery of "problematic" e-mail attachments is preempted so that the attachments in their original format do not accompany the delivered e-mail messages. See Abstract. Although non-problematic attachments might pass filtering and be delivered with messages, *Kirani* does not disclose that such attachments would also be stored in a central repository for subsequent use, as required by Applicants' claim. *Kirani* does not disclose a delivery scenario in which an un-altered, viewable version of an attachment is delivered with a message and also saved in a repository for subsequent use. Rather, *Kirani* merely discloses removing problematic attachments from e-mail messages, storing those attachments, and delivering the messages with "detached" attachments. ¶ 0064.

Because *Kirani* fails to disclose each and every feature of claim 1, the section 102 rejection of this claim based on *Kirani* should be withdrawn. The section 102 rejection of claims 2-13, 15-17 and 19-24 should be withdrawn as well, since each of these claims depends upon claim 1 and is likewise distinguishable from *Kirani*.

Moreover, dependent claims 23 and 24 recite, *inter alia*, "prior to automatically saving the multimedia object, determining whether the multimedia object is stored in the repository." Claim 23 recites "automatically saving the multimedia object in the repository if the multimedia object is not stored in the repository based on the determination." Claim 24 recites "automatically not saving the multimedia object in the repository if the multimedia object is stored in the repository based on the determination." As discussed below, *Kirani* fails to disclose these additional features of claims 23 and 24.

In rejecting claim 23, the Office Action notes the disclosure of a "unique ID" in paragraph 0101 of *Kirani*. See Office Action, p. 4. This portion of the reference merely describes that the media storage repository generates a unique number to represent a uniquely identifiable link for retrieving a media object. It does not disclose "prior to automatically saving

the multimedia object, determining whether the multimedia object is stored in the repository” and “automatically saving the multimedia object in the repository if the multimedia object is not stored in the repository based on the determination,” as claimed. Indeed, even if the unique ID is obtained prior to storage, *Kirani* does not disclose automatically saving a multimedia object in a repository based on a pre-storage determination that multimedia object is not stored in the repository.

In rejecting claim 24, the Office Action again notes *Kirani*'s “unique ID” and also cites to paragraph 0109 of the reference. See Office Action, p. 4-5. As discussed above, *Kirani* merely describes in paragraph 0101 that the media storage repository generates a unique number to represent a uniquely identifiable link for retrieving a media object. Paragraph 0109 merely describes extracting attachments and saving various information in a data structure implemented in the Perl programming language. Neither of these relied-upon paragraphs discloses “prior to automatically saving the multimedia object, determining whether the multimedia object is stored in the repository” and “automatically not saving the multimedia object in the repository if the multimedia object is stored in the repository based on the determination,” as required by dependent claim 24.

For at least these additional reasons noted above, the section 102 rejection of dependent claims 23 and 24 based on *Kirani* should be withdrawn.

Amended independent claim 25 recites a combination including “delivering the electronic message to the destination with an un-altered, viewable version of the separated multimedia object and automatically saving the un-altered, viewable version of the separated multimedia object to a repository for subsequent use by a user.” Amended independent claim 26 recites a combination including “means for delivering the electronic message to the destination with an un-altered, viewable version of the separated multimedia object and automatically saving the un-altered, viewable version of the separated multimedia object to a repository for subsequent use by a user.” Although claims 25 and 26 are different in scope from claim 1 and each other, the section 102 rejection of claims 25 and 26 based on *Kirani* should be withdrawn for at least reasons similar to those presented above in connection with claim 1.

Applicants accordingly request withdrawal of the section 102 rejection and the timely allowance of claims 1-13, 15-17 and 19-26.

### **Section 103 rejection of claims 14 and 18**

Claims 14 and 18 depend upon claim 1. As discussed above, *Kirani* fails to disclose or suggest each and every feature of independent claim 1. *Danker*, which was applied to certain features of claims 14 and 18, fails to cure the deficiencies of *Kirani* with respect to independent claim 1. Furthermore, no basis has been established for concluding that it would have been obvious to a skilled artisan to bridge the gap between the applied references and Applicants' claims. See M.P.E.P. § 2143.01(VI), 8<sup>th</sup> Ed., Rev. 6 (September 2007). Accordingly, *Kirani* and *Danker*—whether taken alone or in any combination—fail to render obvious claim 1 or its dependent claims 14 and 18. Applicants therefore request withdrawal of the section 103 rejection and the timely allowance of dependent claims 14 and 18.

### **Conclusion**

Applicants request the Examiner's reconsideration of the application in view of the amendments and foregoing remarks and the timely allowance of pending claims 1-26.

It is believed that all pending issues in the outstanding Office Action have been addressed by this paper. The Office Action, however, contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action. In addition, there may be reasons for patentability of any or all pending or other claims that have not been expressed above.

If there are any questions regarding this paper or the application generally, Applicants would appreciate a telephone call to the undersigned since this may expedite prosecution of the application.

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Applicants hereby petition that the period for response to the Office Action be extended for one (1) month. The Petition for Extension of Time fee (\$120) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please grant any additional extensions of time required to enter this paper and apply any other required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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